

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 25, 37 and 42 are currently being amended. Support for these amendments can be found throughout the specification and drawings. No new matter is being added.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 25, 27-29, 37, 39-40, 42-43 and 48-50 are now pending in this application.

Rejections under 35 U.S.C. § 103

Claims 25, 27-29, 37, 39, 40, 42, 43 and 48-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,222,157 to Yoneda et al. ("Yoneda") in view of U.S. Patent No. 4,821,107 to Naito et al. ("Naito"). Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoneda and Naito in view of well known prior art. Applicants respectfully traverse these rejections for at least the following reasons.

Independent claim 25, as amended, recites "a control panel including a first touch screen menu including a trial printing button configured to, when user selected, initiate a trial preceding print of image data, and a printing button configured to, when selected by a user, initiate printing of all pages of the image data in response to the selection of the printing button" and "a printer that performs the trial preceding print in response to a command received from an external PC via communication lines and the selection of the trial printing button, and performs the printing of all pages of the image data being received from the PC." Yoneda and Naito fail to disclose at least this feature of claim 25 in the context of that claim, where trial printing is performed immediately in response to both selection of a trial printing button of the control panel as well as a command received from an external PC.

Yoneda discloses in FIG. 12 a conditional display panel 117, which is part of the display section 12 shown in FIG. 10. In the conditional display panel “ALL” or “PARTIAL” may be selected. The Patent Office equates the selection of “ALL” and “PARTIAL” with the printing button and trial preceding print button, respectively, of the claims.

In contrast to claim 25, however, Yoneda does not perform trial printing immediately in response to both selection of a trial printing button as well as a command received from an external PC. That is, Yoneda does not disclose performing trial printing immediately in response to both selection of “PARTIAL” as well as a command received from an external PC.

Naito fails to cure the deficiencies of Yoneda, at least in that Naito fails to suggest that Yoneda should be modified to perform trial printing immediately in response to both selection of “PARTIAL” as well as a command received from an external PC. Naito is a general reference regarding displaying gradation for a document, but does not disclose “trial printing” as recited in claim 1. Moreover, while the Patent Office proffers “the motivation [for combining Yoneda and Naito] would have been to enable printing computer based data and to allow the user to print darker or light documents,” Naito does not vary the gradation of the image on the basis of data transmitted from any external PC. Thus, the Patent Office has provided no properly articulated reason for combining Yoneda and Naito to arrive at the invention as claimed in claim 25.

Moreover, Yoneda and Naito fail to suggest the advantages of the apparatus of claim 25. With the apparatus of claim 25, the user can easily execute the trial printing and can judge whether the desired printing can be executed. Thus, it is possible to prevent sheets from being wasted by undesired printing. Yoneda and Naito fail to suggest the apparatus of claim 25, and fail to suggest the advantages resulting therefrom.

Independent claims 37 and 42 have features corresponding to those discussed above with respect to claim 25 in the context of process claims, and are patentable for analogous reasons.

The dependent claims are patentable for at least the same reasons as their respective independent claims as well as for further patentable features recited therein.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date November 22, 2008

By Thomas G. Bilodeau

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 945-6162
Facsimile: (202) 672-5399

Pavan K. Agarwal
Attorney for Applicant
Registration No. 40,888

Thomas G. Bilodeau
Attorney for Applicant
Registration No. 43,438